

### **REMARKS**

Claims 1, 3, 4, 7-9, 12-14, 21, 24, 27, 30, 31-34, 37, 38, 40 and 48 have been amended, claims 6 and 15-20 have been previously canceled, claims 41-47 have been previously withdrawn and claim 50 has been added; thus claims 1-5, 7-14 and 21-40 and 48-50 are pending in the application. Applicants note with appreciation that claims 12-14 are allowed. In view of the following remarks, it is respectfully submitted that claims 1-5, 7-11, 21-40 and 48-50 are also allowable.

### **Interview Summary**

The undersigned thanks Examiner Dexter for courteously discussing this application during the telephonic interview held on February 7, 2008 during which the following issues were discussed: (i) the claim amendments proposed by Examiner Dexter, the Applicants proposed changes to said amendments, and the patentable differences of the Applicant's proposed claims over the cited art of record; (ii) that the Applicants proposed amendments would raise new issues and, therefore, an RCE would need to be filed to facilitate consideration and entry of the proposed amendments; and (iii) the error in paragraph 13 of the Office Action, which inaccurately states that claims 12-14 were rejected under 35 U.S.C. § 112, second paragraph (claims 12-14 were not rejected under 35 U.S.C. § 112, second paragraph).

### **Claim Objections**

Claims 12-14 were objected to by the Examiner for not being sufficiently clear. Applicants have amended claims 12-14 taking into account the Examiner's suggested amendments. Withdrawal of this objection is respectfully requested.

### **Claim Rejections – 35 U.S.C. § 112, first paragraph**

Claims 1, 2, 5, 9-11, 21, 22, 25-30, 34-37, 48 and 49 stand rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Accordingly, Applicants have deleted the subject matter in question ("at least a portion thereof oriented at an angle of at

least about 90° relative to a back edge portion of the blade in a cutting direction of the blade.”). Withdrawal of this rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 112, second paragraph**

Claims 31-33 and 48-49 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. To address this rejection, Applicants have amended claims 31-33 to provide proper antecedent basis and have amended claims 48-49 to correct the inaccuracy cited by the Examiner. Withdrawal of this rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 102**

Claims 3, 31 and 38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,834,573 to Nakahara, hereinafter “Nakahara”. Applicants respectfully traverse this rejection.

Nakahara is directed to a saw blade for forming small diameter or spring shaped curls from chips, which can be only created in this manner from metal workpieces. In contrast, the saw blade of claim 3 is directed to a wood cutting band saw blade that produces saw dust. Nakahara is thus directed to cutting metal workpieces and improving the characteristics of the metal chips formed therefrom. Nakahara is not concerned in any way with cutting wood, much less with the problems associated with cutting wood and removing sawdust from the kerf when cutting wood. Furthermore, even if the Nakahara blade was designed to address the problems associated with cutting wood and removing sawdust from the kerf when cutting wood, which it does not, Nakahara does not teach a wood cutting band saw blade as defined in any of claims 3, 31 and 38.

Regarding claim 3, Nakahara does teach or suggest a blade “comprising: a cutting edge defined by a plurality of teeth spaced relative to each other, and a back edge including a substantially planar portion located on an opposite side of the band saw blade relative to the cutting edge, the plurality of teeth comprising a plurality of set teeth, each set tooth defining a tip, a bend plane from which the set tooth is set, the bend plane extending substantially parallel to the substantially planar back edge portion of the band saw blade, and a shelf located on a front portion of each set tooth with respect to a cutting direction of the band saw blade and exposed during cutting, the shelf located at least partially between the tip and the bend plane and extends

substantially parallel to the substantially planer back edge portion or extends at an angel in a direction that is opposite the cutting direction and generally toward the back edge of the band saw blade for reducing saw dust passing to the kerf and accumulating on the band saw blade.” Accordingly, Nakahara does not teach or suggest each and every element of amended claims 3, and, therefore, does not anticipate amended claim 3

Regarding claims 31 and 31, Nakahara does teach or suggest a blade “comprising: a base having a back edge including a substantially planar portion, and a cutting edge defined by a plurality of teeth spaced relative to each other and being located on an opposite side of the band saw blade relative to the back edge, the plurality of teeth comprising a plurality of set teeth, each set tooth defining a tip, a bend plane from which the set tooth is set, the bend plane extending substantially parallel to the substantially planer back edge portion of the band saw blade, and a shelf (claim 38) or first means (claim 31) located at least partially between the tip and the bend plane and extending substantially parallel to the substantially planer back edge portion or extends at an angel in a direction that is opposite the cutting direction and generally toward the back edge of the band saw blade for reducing saw dust passing to the kerf and accumulating on the band saw blade

Furthermore, with respect to each of claims 3, 31 and 38, Nakahara does not teach or suggest a ratio of SI/B is within the range of approximately 1/4 to approximately 3/4. The Office Action contends that FIG. 3 shows a ratio of “approximately 1/4”. However, FIG. 3 of Nakahara merely demonstrates that the curl forming section extends from the end of the tooth toward the base of the blade. Nakahara is silent with respect to any relationship between the distance between the tip and the curl forming portion and the distance between the tip and the bend plane. In addition, it appears that the Examiner has estimated a ratio based on mere visual inspection of FIG. 3. As discussed in the M.P.E.P., section 2125, patent drawings may not be relied on to show particular sizes if the specification is silent on the issue, but may be relied on for what they would reasonably teach one of ordinary skill in the art. Nakahara does not provide any information regarding the distance between the tip of the tooth and the bend portion, and further does not provide any information regarding a ratio or other relationship between (i) the distance between the tip and the curl forming portion and (ii) the distance between the tip and the bend plane of the tooth. Furthermore, Nakahara does not give any indication that a ratio as described above would be beneficial or otherwise teach or suggest any reason for providing such a ratio. Thus, Applicants respectfully submit that, in the absence of any information regarding the ratio

or teaching of any benefit to such a ratio, FIG. 3 of Nakamura is not sufficient to demonstrate a teaching of any defined ratio, especially the ratio as recited in claims 3, 31 and 38.

Thus, Nakahara does not teach or suggest a wood cutting band saw blade including a plurality of set teeth, wherein “each of the set teeth has a dimension (SI) defined as the distance between the tip and the shelf of the respective tooth; each of the set teeth has a dimension (B) defined as the distance between the tip and the bend plane of the respective tooth; and a ratio of SI/B is within the range of approximately 1/4 to approximately 3/4,” as recited in claim 3 as amended. Accordingly, claims 3, 31 and 38 are not anticipated by Nakahara.

For at least the above reasons, it is respectfully submitted that the rejection of claims 3, 31 and 38 under 35 U.S.C. § 102(b) as being anticipated by Nakahara is overcome. Applicants respectfully request reconsideration and withdrawal of this rejection in view of the amended claims.

#### **Claim Rejections – 35 U.S.C. §103**

Claims 4, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakahara. Applicants respectfully traverse this rejection.

Claims 4, 7 and 8 depend from claim 3. Thus, for reasoning that is the same as or similar to that provided in support of the patentability of claim 3, claims 4, 7 and 8 are patentable over Nakahara. Withdrawal of this rejection is respectfully requested.

Claims 23, 24, 32, 33, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakahara in view of Japanese Publication 6-716 to Nakahara, hereinafter “JP ‘716”. Applicants respectfully traverse this rejection.

As discussed above, Nakahara does not teach or suggest a wood cutting band saw blade including a plurality of set teeth, wherein “each of the set teeth has a dimension (SI) defined as the distance between the tip and the shelf of the respective tooth; each of the set teeth has a dimension (B) defined as the distance between the tip and the bend plane of the respective tooth; and a ratio of SI/B is within the range of approximately 1/4 to approximately 3/4,” as recited in claim 3 as amended.

JP ‘716 describes a metal cutting saw blade. Similarly to Nakahara, JP ‘716 is directed to forming curls from chips created from metal workpieces. The saw blade teeth of JP ‘716 include a straight-line part extending from a cutting point of the tooth to a chip induction surface that forms a recessed arcuate shape. Chips fed from the straight-line part are guided by the arcuate

surface to effectively generate a curl. However, JP '716 does not describe or suggest a wood cutting band saw blade, or a ratio between (i) the distance between the tip and the curl forming portion and (ii) the distance between the tip of the bend plane of the tooth, as recited in claim 3 as amended.

Thus, Nakahara and JP '716, whether considered alone or in combination, do not teach or suggest a wood cutting band saw blade including a plurality of set teeth, wherein "each of the set teeth has a dimension (SI) defined as the distance between the tip and the shelf of the respective tooth; each of the set teeth has a dimension (B) defined as the distance between the tip and the bend plane of the respective tooth; and a ratio of SI/B is within the range of approximately 1/4 to approximately 3/4," as recited in claim 3 as amended.

Claims 23 and 24 depend from claim 3, claims 32 and 33 depend from claim 31, and claims 39 and 40 depend from claim 38. Thus, for at least the above reasons and for reasoning that is the same as or similar to that provided in support of the patentability of claims 3, 31 and 38, claims 23, 24, 32, 33, 39 and 40 are patentable over the cited combination of Nakahara and JP '716. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 23, 24, 32, 33, 39 and 40.

### **Allowable Subject Matter**

Applicants thank the Examiner for the indication of allowable subject matter in claims 12-14. As noted above, the Applicants have amended claims 12-14 taking into consideration the Examiner's suggested amendments to overcome the objections cited on pages 4 and 5 of the Office Action. Allowance of claims 12-14 is respectfully requested.

### **Double Patenting**

Applicants acknowledge the Examiner's advisory that should claims 31-33 be allowed, claims 38-40 would be rejected under 37 C.F.R. §1.75 as being substantially duplicative (or vice versa as appropriate). Applicants respectfully submit that claims 31-33 and 38-40 are not duplicative, as claims 31-33 include means-plus-function language, while claims 38-40 do not include means-plus-function language. Hence, the scope of claims 31-33 is not identical to the scope of claims 38-40 and, therefore, double patenting would not occur.

**Conclusion**

All issues raised by the Examiner having been addressed, an early allowance of the claims is earnestly solicited.

If the Examiner has any questions in connection with this paper, or otherwise if it would facilitate the examination of this application, he is respectfully requested to call the undersigned at the telephone number below.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorneys hereby authorize that such fee(s) be charged to Deposit Account No. 50-3569.

Respectfully submitted,

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